

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Examiner: Eric E. Silverman

Syed F.A. Hossainy

Serial No. 10/815,421 Art Unit: 1615

Filed: March 31, 2004 Confirmation No. 7688

Title: **BIOCOMPATIBLE POLYACRYLATE COMPOSITIONS FOR MEDICAL APPLICATIONS**

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY TO EXAMINER'S ANSWER

Dear Sir:

This communication is a reply to the Examiner's Answer mailed on October 15, 2008.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue presented in this appeal is:

- (1) Whether claims 31-41, 47-49, 51 and 52 are obvious over Whitbourne in view of WO 2004/101018 under 35 U.S.C. 103(a).

ARGUMENT

I. The Examiner's claim interpretation is improper.

The claim rejections are based on the Examiner's improper claim construction. The Examiner did not follow the USPTO's guideline on claim construction. The MPEP in various sections provides guideline on claim construction.

MPEP 2111.01, I provides that during patent examination, the USPTO employs the "broadest reasonable interpretation" standard. This is because the USPTO has a different role than that of a district court and an applicant always has opportunity to amend the claims during the prosecution so that the claims, once issued, will not be interpreted more broadly than justified.

In construing a claim, "the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)." MPEP 2111.01, I. "Plain meaning" refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. MPEP 2111.01, III.

MPEP 2111.01, III also provides that the ordinary and customary meaning of a term may be evidenced by a variety of sources, including "*the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.*" *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327. (emphasis added). The meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the

specification and drawings." *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). MPEP 2111.01, IV.

The Examiner insisted on interpreting "block polymer" to include a physical mixture of homopolymers thereby giving the claim the broadest interpretation. Appellant respectfully submits that the Examiner's interpretation is **not reasonable**, however.

Among the descriptions, the second paragraph on page 5 of the specification states:

"These blocks need not be linked at the ends, *since the values of the integers determining block length ensure that the individual blocks are polymers in their own right*. Accordingly, the ABA-block copolymer can be named poly A-block-co-poly B-block-co-poly A-block copolymer, the ABC-block copolymer can be named poly A-block-co-poly B-block-co-poly C-block copolymer and the AB-block co-polymer can be named poly A-block-co-poly B-block copolymer. Blocks A, B, and C can be longer than three blocks and can be alternating or random." (emphasis added)

Put in context but not lexicographic vacuum, the statement of "these blocks need not be linked at the ends" means that the blocks are polymers in their own right, and is not intended to define a block copolymer to be absurdly inconsistent with its ordinary meaning. The remainder of the specification contains more definition or specific embodiments of a block copolymer, all of which are uniformly resonant with its ordinary meaning which does not encompass a physical mixture of homopolymers. Notably, the second full paragraph on page 4 of the specification states "*[T]he terms 'block copolymer' and 'graft copolymer' follow the terminology used by the International Union of Pure and Applied Chemistry (IUPAC)*." (emphasis added)

Further, during the prosecution of the present application, Appellant has clarified on record that the term "copolymer" does not include a physical mixture of homopolymers. *See* Appendix H accompanying the Appeal Brief, page 21.

Appellant requests the term "copolymer" be construed to have its ordinary meaning in the art because such construction is consistent with the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning

of technical terms, and the state of the art. Moreover, such construction does not bring any danger of expanding the scope of the claims unjustly once issued.

II. The Examiner is erred in using WO 2004/101018 as prior art under 35 U.S.C. §103(a).

As Appellant pointed out in a reply filed on January 9, 2008, WO 2004/101018 would be a 102(e) reference and therefore should be disqualified as a prior art reference pursuant to 35 U.S.C. §103(c). *See* Appendix F accompanying the Appeal Brief, page 21. With that reply, a Statement of Common Ownership was filed, which correctly stated that at the time the invention of the current application was made, the inventions of the current application and WO 2004/101018 were owned or subject to an obligation of assignment to Advanced Cardiovascular Systems, Inc. *See* Appendix F accompanying the Appeal Brief, last page.

The following office action mailed on March 18, 2008 indicates that the Examiner, while commenting on Appellant's remarks, failed to consider the Statement.

Appellant respectfully submits that the Statement filed on January 9, 2008 is sufficient to disqualify WO 2004/101018 as prior art pursuant to 35 U.S.C. §103(c).

III. Claims 31-41, 47-49, 51 and 52 are not obvious over Whitbourne in view of WO 2004/101018 under 35 U.S.C. §103(a).

Claim 31 defines a medical article comprising an implantable medical device and a coating deposited on at least a part of the device. The coating includes (a) a structural component comprising a linear acrylic homopolymer or linear acrylic copolymer; and (b) a biobeneficial component comprising a copolymer having an acrylate moiety and a biobeneficial moiety.

Whitbourne describes a coating formed of poly(butyl methacrylate) (PBMA). As the Examiner correctly notes, Whitbourne fails to describe or teach a coating that includes a biobeneficial component comprising a copolymer having an acrylate moiety and a biobeneficial moiety.

WO 2004/101018 is disqualified as prior art for the reason set forth above. Even if it

were qualified as prior art, it would fail to make up Whitbourne's deficiency. WO 2004/101018 discloses a coating that can include a mixture of homopolymers PEG and PBMA. It does not describe or teach a coating that includes a biobeneficial component comprising a copolymer having an acrylate moiety and a biobeneficial moiety. Construed properly, the term "copolymer" as recited in claim 31 does not include a physical mixture of homopolymers PEG and PBMA for the reasons set forth above.

In sum, Claim 31 is patentable over Whitbourne or Whitbourne in view of WO 2004/101018 under 35 U.S.C. §103(a). Claims 32-41, 47-49, 51 and 52 depend from claim 31 and are patentable over Whitbourne under 35 U.S.C. §103(a) for at least the same reasons.

CONCLUSION

The Examiner has failed, as a matter of law, to establish a *prima facie* case of obviousness of 31-41, 47-49, 51 and 52 over Whitbourne or Whitbourne in view of WO 2004/101018 under 35 U.S.C. 103(a).

Appellant therefore respectfully requests that the Board reverse the rejections and order the application to be passed to issue.

Respectfully submitted,

Date: December 3, 2008 By /Qun Liu/
SQUIRE, SANDERS & DEMPSEY LLP
One Maritime Plaza, Suite 300
San Francisco, CA 94111
Telephone: (415) 954-0313
Facsimile: (415) 393-9887
Qun Liu, Esq.
Attorney for Appellant
Registration No. 55,392